UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/537,506	03/29/2000	Judith Continelli	10655.9400	6236

7590 09/13/2004

Snell & Wilmer L L P
One Arizona Center
400 East Van Buren
Phoenix, AZ 85004-2202

EXAMINER	
BACKER, FIRMIN	
ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/537,506	CONTINELLI ET AL.	
	Examiner	Art Unit	
	Firmin Backer	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 April 2004* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16 and 19-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16 and 19-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☒ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-7, 9-16, 19-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Rosen (U.S. Patent No 6,336,095) in view of Wang et al (U.S. PG Pub 2002/0082929).

3. As per claim 1, Rosen teaches a system for facilitating communication between an issuer and an acquirer in the context of resolving a post-transaction al dispute (*dispute regarding transaction)* regarding a pre-exsisting charge, wherein the dispute is between the issuer and the acquirer and is related to an execute credit transaction between a cardmember and as service establishment the involving a cardmember's transaction card issue to the cardmember by the issuer under a cardmember agreement for a cardmember account, wherein the transaction card is accepted by the service establishment under terms previously agreed to with the acquirer (*see fig 1, column 28 lines 42-30 line 47)* comprising at least one access terminal having a display and an input means (*see fig 1)* a central server having an Internet web site stored thereon, the display capable of displaying a predefined set of plurality of available handling forms retrieved from the server wherein the issuer selects a particular one of the available forms utilizing the input means (*see fig 1, column 28 lines 42-30 line 47)* and a communication channel linking the terminal to

the web site and the server to the web site (*see fig 1, column 28 lines 42-30 line 47).* Rosen fails to teach an inventive concept of displayed form comprises a pre-defined set of available forms that are available only to the issuers. However, Wang et al teach inventive concept of displayed form comprises a pre-defined set of available forms that are available only to the issuers (*see paragraphs 0008, 0023-0026, 0032-0035).* Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the inventive concept of Rosen to include Wang et al's inventive concept of displayed form comprises a pre-defined set of available forms that are available only to the issuers because this would have facilitate the user in providing information concerning the dispute thereby enhance the system in expediting the dispute process.

4. As per claims 2 and 6, Rosen teaches a system comprising a first access terminal for an issuer and a second access terminal for an acquirer and a third access terminal for administration and a fourth access terminal for finance (*see fig 1, column 28 lines 42-30 line 47).*

5. As per claims 3-5, Rosen teaches a system comprising a form selection for an issuer and a form selection for an acquirer/responder wherein the form selection for the issuer/initiator comprises a Retrieval Request , a First Chargeback and a Final Chargeback; and the form selection for the responder comprises a Fulfillment and a Second Presentment (*see fig 1, column 28 lines 42-30 line 47).*

6. As per claim 7, Rosen teaches a system for facilitating communication between an issuer and an acquirer in the context of resolving a post-transaction al dispute (*dispute regarding*

transaction) regarding a pre-exsisting charge, wherein the dispute is between the issuer and the acquirer and is related to an execute credit transaction between a cardmember and as service establishment the involving a cardmember's transaction card issue to the cardmember by the issuer under a cardmember agreement for a cardmember account, wherein the transaction card is accepted by the service establishment under terms previously agreed to with the acquirer (*see fig 1, column 28 lines 42-30 line 47)* comprising at least one accessing by the issuer the dispute resolution system form from the terminal liked to a server having plurality of available handling forms having predefined content selecting by the issuer a particular one of the available forms utilizing the input means (*see fig 1, column 28 lines 42-30 line 47)* responding to the requested field information on the form, sending the form over the Internet connection to be routed by the server to a disputed party; and repeating steps (a)-(d) for both the Issuer and the Acquirer (*see fig 1, column 28 lines 42-30 line 47)*. Rosen fails to teach an inventive concept of displayed form comprises a pre-defined set of available forms that are available only to the issuers. However, Wang et al teach inventive concept of displayed form comprises a pre-defined set of available forms that are available only to the issuers (*see paragraphs 0008, 0023-0026, 0032-0035).* Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the inventive concept of Rosen to include Wang et al's inventive concept of displayed form comprises a pre-defined set of available forms that are available only to the issuers because this would have facilitate the user in providing information concerning the dispute thereby enhance the system in expediting the dispute process.

7. As per claim 8, the combination of Rosen and Wang et al fail to teach a method further comprising at least one document scanning device and scanning at the document scanning device

at least one supporting document; and sending the supporting document along with the form over the Internet connection to be routed by the server to a disputed party. However the concept of scanning and sending document is well in the art. Therefore, it would have been obvious to one of ordinary skill in that art at the time the invention was made to modify Rosen to include the concept of scanning and sending document because this would facilitate the collection of document needed for and effective dispute.

8. As per claim 9, Rosen teaches a method wherein the scanning comprises one to five supporting documents (*see fig 1, column 28 lines 42-30 line 47).*

9. As per claim 10, Rosen teaches a method further comprising reviewing a report comprising the form by financial operations; and transferring liability in response to the report to at least one of the Issuer from Acquirer and the Acquirer from the Issuer (*see fig 1, column 28 lines 42-30 line 47).*

10. As per claim 11, Rosen teaches a method of requesting a User ID from administrative operations; and receiving the User ID and a password (*see fig 1, column 28 lines 42-30 line 47).*

11. As per claim 12, Rosen teaches a method wherein the choosing one of the dispute handling forms comprises choosing from a form selection for the Issuer and a form selection for the Acquirier (*see fig 1, column 28 lines 42-30 line 47).*

12. As per claim 13, Rosen teaches a method wherein the form selection for the issuer comprises a Retrieval Request, a First Chargeback and a Final Chargeback; and the form selection for the Acquirer comprises a Fulfillment and a Second Presentment (*see fig 1, column 28 lines 42-30 line 47).*

13. As per claim 14, Rosen teaches a method wherein the sending step comprises one of viewing and downloading by the disputed party (*see fig 1, column 28 lines 42-30 line 47).*

14. As per claims 15, 16, and 19-46, they contain inventive concepts that are identical to claims 1-14. Therefore, they are rejected by the same rationale.

Response to Arguments

15. Applicant's arguments filed April 23rd, 2004 have been fully considered but they are not persuasive.

a. Applicant argues that the prior art fail to teach a system for facilitating communication between an issuer and an acquirer in the context of resolving a post-transactional dispute wherein the dispute is between the issuer and the acquirer. Examiner respectfully disagrees with Applicant's characterization of the prior art. Rosen teaches a system wherein if the customer is not satisfied with the result of the dispute interaction with the merchant, he can take his complaint to a Trusted Agency. The customer's transaction log shows that the dispute was denied by the merchant first. The dispute and accompanying documentation can be presented to a trusted server. The interaction is then

similar to the interaction with the merchant's trusted agent The trusted agent sending electronic merchandise and dispute information to a merchant trusted agent. The trusted agency acts on behalf of the customer and the merchant. According to ordinary skilled in the art a trusted agent can be a financial institution, which in turn can be an issuer and acquirer a customer. Therefore the system facilitate communication between the customer's trusted agent (issuer) and the merchant's trusted agent (acquirer).

b. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combine inventive concepts are in the same environment and are definitely combinable.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Firmin Backer
Primary Examiner
Art Unit 3621

September 9, 2004